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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,855	06/22/2001	Dirk M. Anderson	2883-US	8635
22932	7590	10/03/2003	EXAMINER	
IMMUNEX CORPORATION LAW DEPARTMENT 51 UNIVERSITY STREET SEATTLE, WA 98101			MITRA, RITA	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/887,855

Applicant(s)

ANDERSON, DIRK M.

Examiner

Rita Mitra

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the claims

Applicants' preliminary amendment filed on September 19, 2001 (paper #5) is acknowledged. Amendment to specification at page 1 has been noted. Claims 1-13 are pending and under examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 8-11, drawn to an isolated nucleic acid molecule selected from the group a) the DNA sequence of SEQ ID NO: 1; b) a nucleic acid molecule encoding an amino acid sequence comprising the sequence of SEQ ID NO: 2; c) a nucleic acid molecule that hybridizes to either strand of a denatured double stranded DNA comprising the nucleic acid sequence of (a) or (b); d) and e) mutants and variants; f) selected from the group consisting of human and mouse ss3939DNA, and allelic variants/species homologues thereof; an expression vector; a recombinant host cell; a method for the production of ss3939 polypeptide, comprising culturing the a host cell of claim 8, and recovering the polypeptide from the culture medium, wherein the host cell is selected from the group consisting of bacterial cells, yeast cells, plant cells and animal cells; classified in Class 435, subclass 69.1, 252.3, 320.1, 325, 410; class 536, subclass 23.1, 23.5.

Should Group I be elected, applicants are required to select one host cell from claim 10.

- II. Claims 3-5, 12 and 13, drawn to an isolated polypeptide encoded by the nucleic acid molecule of claim 1; an isolated ss3939 polypeptide comprising an amino acid sequence selected from the group consisting of amino acid sequence of SEQ

ID NO; 2, 5, 6 and fragments thereof; an oligomer comprising a polypeptide of claim 3; classified in Class 530, subclass 350; Class 536, subclass 23.5

Should Group II be elected, applicants are required to select one amino acid sequence of SEQ ID NOs listed in claim 12.

- III. Claims 6 and 7, drawn to an antibody specific for polypeptide of claim 3; classified in Class 530, subclass 387.1+.

The inventions are distinct, each from the other because of the following reasons:

The nucleic acid of invention I and protein of invention II is related to by virtue of the fact that the DNA codes for the protein. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA and the protein are related, since the DNA encodes the specifically claimed protein, they are distinct inventions because the protein product can be made by other and materially distinct processes, such as purification from the natural source. Further, DNA can be used for processes other than the production of protein, such as nucleic acid hybridization assays. Therefore, the inventions are distinct.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the nucleic acid of invention I is a separate and distinct chemical entity from antibody of invention III. The nucleic acid has different functions from the antibody of III. Therefore the inventions are distinct.

The polypeptide of invention II is related to the antibody of invention III by virtue of being the cognate antigen necessary for the production of antibody. Although the protein and antibody are related due to the necessary steric complementarity of the two, they are distinct inventions because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein if it is a receptor. Further, a protein and its

cognate antibody are structurally and functionally distinct molecules with different amino acid compositions. Therefore, the inventions are distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A telephone call was made to Attorney Suzanne Sprunger on May 16, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rita Mitra whose telephone number is (703) 605-1211. The Examiner can normally be reached from 9:30 a.m. to 6:30 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242. Any inquiry of a general nature or relating to the

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status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rita Mitra, Ph.D.

September 30, 2003



CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600